

REMARKS

Section 112 Rejection

Claims 1, 17, 19-20 were rejected under 35 U.S.C. 112, second paragraph. Claim 17 has been amended to overcome the rejection. There is no specific objection to claim 19 and thus claim 19 is definite. As to claim 20, the examiner indicated that drill down is vague. Applicant respectfully disagrees. It is commonly understood that drill down means to go through a series of items to find information. To drill down through a series of folders, for example, on a desktop means to go through the hierarchy of folders to find a specific file or to click through drop-down menus in a GUI. To drill down through a database is to access information by starting with a general category and moving through the hierarchy of field to file to record. See http://isp.webopedia.com/TERM/D/drill_down.html. Hence, the term drill down is not vague and indefinite to one skilled in the art. Applicant submits that all claims overcome the rejection. Withdrawal of the rejection is requested.

Applicant has canceled claims 2-15 and added new claims to fulfill the 20 claims limit. New claims 21-29 are supported by pages 3-4 of the Specification. New claims 30-31 are supported by pages 7-8 of the Specification. New claim 32 is supported by page 12 of the Specification. New claims 33-34 are supported by page 13 of the Specification. No new subject matter has been added.

Section 102 Rejection

Claims 1 and 16-20 were rejected under 35 U.S.C. 102(a) as being anticipated by Riodan, NY Times article. The Office Action asserted that

The applicant has interpreted the system to read on computer terminal. Applying the art to the instant claims, the "online market" (page 3) of the prior art, inherently possessing a user interface and a database, anticipated the claimed apparatus. The prior art also anticipated Claims 2-7 which only require an interface. Claim 9-12, and 13 reads on a chat room to which the examiner takes official notice exist in internet market places.

Applicant respectfully traverse the rejection. For a Section 102 rejection, MPEP § 2131 provides that:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Here, the rejection is improper since the prior art reference relied upon by the examiner in a § 102 rejection does not contain every element recited in the claim in as complete detail as is contained in the claim and arranged as recited in the claim. No where in Riodan does it show the claimed specifics of a system to support trading of intellectual property (IP) with a user interface displayed by the processor to accept a request to trade an IP asset; a user interface displayed by the processor to store information on the IP asset including rating information; and a database coupled to the user interface and to the processor to store data. associated with one or more IP assets, the database supporting the trading of the IP asset. Withdrawal of the rejection is requested.

As to the Examiner's official notice and inherency argument, Appellant notes that the Examiner must provide rationale or evidence tending to show inherency. M.P.E.P. § 2112. The fact that a certain result may occur in the prior art is not sufficient to establish inherency of that result. *Id.* As the court noted in *In Re Roberston*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. Inherence, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In the instant case, the Examiner has not provided any rationale or evidence in the reference proving that Riodan shows the processor and the database or that the Riodan system supports trading patents that are about to be abandoned. Withdrawal of all rejections is requested.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at (408) 528-7490 or fax at (408) 528-1490.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bao Tran", with a long horizontal flourish extending to the right.

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